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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/649,419	05/16/96	RHOADS G	4830-45053/W

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EXAMINER	
COUSO, J	
ART UNIT	**PAPER NUMBER**
2721	

DATE MAILED: 05/14/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.	Applicant(s)
08/649,419	RHOADS
Examiner	**Group Art Unit**
J.L. - Caso	2721

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 4/27/98.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 2 - 21 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2 - 19 is/are rejected.

☒ Claim(s) 20 - 21 is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 21

☐ Interview Summary, PTO-413

☐ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

1. Applicant should indicate the relevant portion of the last cited reference, namely the Cheong book. This is necessary because it is unclear to the examiner which pages are relevant to the claimed invention. When applicant indicates the relevant pages, the examiner will gladly consider the cited reference.

2. Applicant's corrections and clarifications overcome the rejection of the claims under 35 U.S.C. § 132, the examiner is therefore withdrawing the rejection.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al. ('788) in view of Shear.

Powell et al. ('788) disclose a method and system for digital image signatures.

As to claim 2, Powell et al. ('788) provide for automatically downloading data, including empirical data sets, from a plurality of computer sites (refer for example to column 1, lines 12-21 and column 2, line 60 through column 3, line 17);

for each of a plurality of empirical data sets obtained by the downloading operation, automatically screening same to identify the potential presence of identification data steganographycally embedded therein (refer for example to column 5, line 49 through column 6, line 43); for each of a plurality of empirical data sets screened by the screening operation, discerning identification data, if any, steganographycally encoded therein (refer for example to column 6, line 44 through column 7, line 14); and generating a report identifying steganographycally encoded empirical data sets identified by the foregoing steps, and the site from which each was downloaded (refer for example to column 1, lines 12-49 and column 5, lines 44-54).

Although Powell et al. ('788) do not specifically state that the image data is automatically downloaded from a plurality of computer sites over the internet, the automatically downloading of data is well known and widely utilized in the prior art.

Shear discloses a data base usage metering and protection system and method which specifically discusses the automatically downloading of data from a plurality of computer sites over the internet (refer for example to column 1, lines 33-49).

Given the teachings of the two references and the same environment of operation one of ordinary skill in the art at the

time the invention was made would have been led in an obvious fashion to provide for automatically downloading of data from a plurality of computer sites over the internet as taught by Shear in the Powell et al. ('788) system since both systems are primarily concerned with the usage of and protection of digital data. This is a routine design choice which fails to patentably distinguish over the prior art absent some novel and unexpected result.

In regard to claims 3 and 12, Powell et al. ('788) provide for including a master code signal, and using the code signal in discerning the steganographycally encoded identification data from the screened empirical data sets (refer for example to column 6, lines 18-43).

With regard to claims 4 and 13, Powell et al. ('788) provide for the master code signal to have the appearance of unpatterned snow if represented in the pixel domain (see figures 2, 3 and 5).

As to claims 5 and 14, Powell et al. ('788) provide for discerning of identification data from the downloaded empirical data to be accomplished without previous knowledge of the audio, image, or video information represented therein (refer for example to column 6, lines 18-43).

In regard to claims 6 and 15, Powell et al. ('788) provide for including identifying proprietors of empirical data sets by reference to identification data steganographycally discerned therefrom, and reporting to the proprietors the sites from which their empirical data sets were downloaded (refer for example to column 1, lines 12-49 and column 5, lines 44-54).

With regard to claims 7 and 16, Powell et al. ('788) provide for the identification data to include information in addition to data identifying the proprietor, and the method includes providing the additional data to the proprietors (refer for example to column 1, lines 12-14 and column 5, lines 44-54).

As to claims 8 and 17, Powell et al. ('788) provide for the identification data is a serial number index to registry database containing names and contact information for proprietors identified by the identification data (refer for example to column 1, lines 12-14 and column 5, lines 44-54).

In regard to claims 9 and 18, Powell et al. ('788) provide for the empirical data to include image data (as shown in figures 2, 3 and 5); and the method includes converting the image data to pixel form, if not already in the form (as shown in figure 2, 3 and 5); and performing a plurality of statistical analyses on the

pixel form image data to discern the identification data therefrom (refer for example to column 6, lines 18-43).

With regard to claims 10 and 19, Powell et al. ('788) provide for each statistical analysis to include analyzing a collection of spaced apart pixels to decode a single, first bit of the identification data therefrom, the analysis to decode the first bit encompassing not just the spaced apart pixels, but also pixels adjacent thereto, the adjacent pixels not being encoded with the first bit (refer for example to column 6, lines 18-43).

As to claim 11, Powell et al. ('788) provide for providing a master code signal useful for detecting steganographic coding within empirical data sets (refer for example to column 6, lines 18-43); automatically downloading data, including empirical data sets, from a plurality of computer sites (refer for example to column 1, lines 12-21 and column 2, line 60 through column 3, line 17); for each of a plurality of empirical data sets obtained by the downloading operation, discerning certain identification data, if any, steganographycally encoded therein, the discerning employing the master code signal as a decoding key (refer for example to column 5, line 49 through column 6, line 43); and generating a report identifying steganographycally empirical data sets identified by the foregoing steps, and the site from which

each was downloaded (refer for example to column 1, lines 12-49 and column 5, lines 44-54).

5. Claims 20-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Applicant's arguments filed April 27, 1998 have been fully considered but they are not persuasive.

The examiner has thoroughly reviewed applicant's arguments but firmly believes the cited reference to reasonably and properly meet the claimed limitations.

With respect to applicant's arguments on pages 4-7, applicant states "The Office failed to respond to applicant's detailed arguments, filed December 15, particularly rebutting each of the factual underpinnings on which such rejections were earlier based", the examiner respectfully disagrees. The examiner will like to point out that section 3 of the previous Office action clearly states "Applicant's arguments with respect to claims 2-19 have been considered but are moot in view of the new ground(s) of rejection". To answer to specific arguments which were directed to the previous rejections, which were subsequently dropped, would be irrelevant to the issue at hand as well as

erroneous to the record. For example on page 4 applicant state "Powell does not appear to disclose the automatic downloading of data, including empirical data sets, from a plurality of computer sites over the internet. The internet is not referenced in Powell". Clearly the outstanding rejection of the claims over the combination of Powell and Shear, indicate that Powell fails to disclose this particular limitation, this much has been conceded by the examiner. As to the other limitations in claim 1 and limitations in other claims, the examiner has pointed out where in Powell this limitations are found. While applicant may disagree with such an interpretation, applicant is reminded that the examiner is entitled to give the broadest reasonable interpretation to the language of the claims. The examiner is not limited to applicant's definition which is not specifically set forth in the claims. In re Tanaka et al., 193 USPQ 139, (CCPA) 1977.

With regard to applicant's arguments on pages 8-10, applicant arguments seem to be directed towards an aspect of the invention not specifically claimed. Appellant is reminded of 37 CFR §1.111(b) which specifically states:

> *A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them*

from the reference does not comply with the requirements of this section.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jose L. Couso whose telephone number is (703) 305-4774. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached on (703) 305-4706. The fax phone number for this Group is (703) 308-5397.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-8576.

jlc
May 12, 1998

JOSE L. COUSO
PRIMARY EXAMINER